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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jordan Outdoor Enterprises, Ltd.

Serial No. 78298898

Peter G. Pappas of Sutherland Asbill & Brennan LLP for
Jordan Outdoor Enterprises, Ltd.

Janice L. McMorrow, Trademark Examining Attorney, Law
Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Walters, Bucher and Cataldo, Administrative
Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Jordan Outdoor
Enterprises, Ltd. to register the mark REALTREE HARDWOODS
GREEN HD in standard character form on the Principal
Register for "cotton, wool, or synthetic fabrics having
camouflage patterns."¹

¹ Application Serial No. 78298898 was filed September 11, 2003, based on applicant's assertion of June 26, 2001 as the date of first use of the mark anywhere and in commerce. In its original application, applicant claimed ownership of the following registrations: 0192861, 1736108, 1889683, 1910072, 1917832, 1957418, 2095442, 2143458, 2146099, 2206463, 2267415, 2358478, 2363055, 2400530 and others. In response to the examining

The trademark examining attorney initially required applicant to submit a substitute specimen that shows use of the mark as it appears in the drawing.

When the requirement was made final, applicant appealed. Applicant and the examining attorney filed main briefs and applicant filed a reply brief. Applicant's request for an oral hearing was granted; and an oral hearing was held as scheduled on June 22, 2006.²

The specimen at issue on appeal is reproduced below:



attorney's first Office action, applicant submitted a disclaimer of the wording HARDWOODS GREEN apart from the mark as shown. We note that at the time of filing of the involved application, a mark appearing in standard character form was identified by the term "typed drawing."

² Examining attorney Toni Y. Hickey represented the Office at oral hearing in the place of examining attorney Janice L. McMorrow.

Applicant argues that REALTREE is its well-known brand name; that applicant has previously registered numerous REALTREE and REALTREE formative marks; that the wording BILL JORDAN'S, which appears on the specimen at issue herein, also appears in many of the specimens of use relied upon in its registrations; but that BILL JORDAN'S is not part of the corresponding registered marks; that applicant owns Registration No. 2687376 for the subject mark, REALTREE HARDWOODS GREEN HD, for goods in International Class 16; that, as a result, REALTREE HARDWOODS GREEN HD clearly is recognized as a trademark belonging to applicant; and that the Office accepted a specimen of use in the application that matured into its Registration No. 2687376 that is identical to the one submitted herein. Applicant further argues that its REALTREE HARDWOODS GREEN HD mark creates a separate and distinct commercial impression from the composite mark, BILL JORDAN'S REALTREE HARDWOODS GREEN HD HIGH DEFINITION, appearing on its specimen of record; that the wording BILL JORDAN'S and HIGH DEFINITION appear in very small font in comparison to the wording REALTREE HARDWOODS GREEN HD comprising the applied-for mark; and that its applied-for mark thus is complete and not a mutilation of the composite mark appearing on the specimen.

The examining attorney maintains that the mark as shown in the specimen of record is not a substantially exact representation of the mark as it appears in the application drawing page. Specifically, the examining attorney contends that the specimen of record displays the mark as BILL JORDAN'S REALTREE HARDWOODS GREEN HD HIGH DEFINITION, with the wording HD and HIGH DEFINITION contained in a separate design element; that the specimen thus displays matter, namely, BILL JORDAN'S and HIGH DEFINITION, that is not included in the drawing; and that, in addition, the placement of the wording HD and HIGH DEFINITION "in a separable design element leads to the conclusion that the drawing of record and the specimen simply do not match." (brief, unnumbered page 2) The examining attorney further argues that the wording BILL JORDAN'S and HIGH DEFINITION are fully integrated into the mark as it appears in the specimen of record; that "these terms change the sound, meaning and commercial impression of the proposed mark as filed;" (brief, unnumbered page 3) that applicant would not be permitted to add these terms to its drawing because such amendment would constitute a material alteration of the mark; that applicant thus "is seeking to draw out from the specimen only those portions of the proposed mark convenient to registration;" (brief,

unnumbered page 4) and that, as a result of the foregoing, "the specimen of record is not acceptable to show use of the proposed mark as depicted on the drawing page." *Id.*

Applicant argues in reply that a "trademark is not mutilated simply because it is surrounded by or combined with other marks;" (reply brief, page 1) that the applied-for mark in this case creates a separate commercial impression from the other material appearing on its specimen of use; that BILL JORDAN'S and HIGH DEFINITION are also trademarks owned by applicant; and that it is not necessary for applicant to include BILL JORDAN'S and HIGH DEFINITION in the instant mark to create a distinct commercial impression. Applicant further argues that the wording REALTREE HARDWOODS GREEN in its mark is "aligned with 'HD' slightly offset in a triangle;" (reply brief, page 2) and that the "examining Attorney has cited no authority to support the position that all words of a mark must be perfectly aligned to be a substantially exact representation." *Id.*

Before turning to the requirement at issue, we note that applicant has submitted with its brief several exhibits, consisting of printouts from applicant's Internet website; as well as copies of specimens of use submitted in connection with certain of applicant's registrations and

declarations of use and incontestability filed therewith. We find that these exhibits are manifestly untimely, and they have not been considered. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal). We note, however, that had we considered these exhibits in our determination of the issue on appeal, the result would be the same.

Turning now to the matter on appeal, Trademark Rule 2.51 provides that "the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services." The issue in this case concerns the deletion of two elements, consisting of the wording BILL JORDAN'S and HIGH DEFINITION, that appear in the specimen. The question is whether the mark sought to be registered is a "mutilation" or an incomplete representation of the mark that is actually used. See, e.g. *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999).

It is well settled that an applicant may seek to register any portion of a composite mark if that portion presents a separate and distinct commercial impression which indicates the source of applicant's goods or services and distinguishes applicant's goods or services from those of others. See *Institut National des Appellations*

D'Origine v. Vintners International Co. Inc. 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992); and *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988). If the portion of the mark sought to be registered does not create a separate and distinct commercial impression, the result is an impermissible mutilation of the mark as used.

As noted by our primary reviewing Court in *Chemical Dynamics, supra* at 1829, quoting 1 J. T. McCarthy, *Trademarks and Unfair Competition* §19:17 (2d ed. 1984), the issue of mutilation "all boils down to a judgment as to whether that designation for which registration is sought comprises a separate and distinct 'trademark' in and of itself."

We agree with applicant that REALTREE HARDWOODS GREEN HD composite shown in the drawing creates a separate commercial impression apart from the wording BILL JORDAN'S and HIGH DEFINITION. Contrary to the examining attorney's contention, the mere fact that two or more elements of a composite mark are in close proximity to each other does not necessarily mean that those elements cannot be registered separately. Proximity is a consideration, but it is the overall commercial impression of the mark that is controlling. Here, the terms BILL JORDAN'S and HIGH

DEFINITION are proximate to the portion of the composite sought to be registered, but are rendered in a different manner from REALTREE HARDWOODS GREEN HD such that the latter creates a distinct commercial impression. In particular, the terms BILL JORDAN'S and HIGH DEFINITION appear in much smaller size and slightly different stylization than the wording comprising the mark, REALTREE HARDWOODS GREEN HD, and it is also less prominent than the wording in the mark. Thus, we view BILL JORDAN'S and HIGH DEFINITION as a visually insignificant parts of the composite mark such that their removal does not disturb any aspect of the mark's visual continuity.

Further, we are not persuaded that the presence of the wording HD in a different design carrier from the remainder of the wording in the mark creates such a separation that the whole mark, REALTREE HARDWOODS GREEN HD, cannot be viewed as having a separate and distinct commercial impression. As depicted in the specimen of record, the wording REALTREE HARDWOODS GREEN appears in a slightly offset oval carrier with the top half colored black and the bottom half red. The wording HD appears in a triangular yellow carrier positioned in such a way that the yellow triangle is superimposed upon the lower right hand portion of the oval. Thus, the oval and triangular carriers

containing the wording that comprises the mark are not remote from one another in the specimen. Rather, they are in such close proximity that the yellow triangle overlaps the black and red oval. In addition, the carriers are positioned such that the wording HD is on the same plane, and immediately follows, the wording HARDWOODS GREEN. As such, the two carriers are united so that the mark, REALTREE HARDWOODS GREEN HD, appears in the specimen in a manner that agrees with the mark as depicted in the drawing.

Accordingly, we find that the REALTREE HARDWOODS GREEN HD composite creates a separate and distinct commercial impression apart from BILL JORDAN'S and HIGH DEFINITION, and that it therefore may be registered as a mark.

In view of the foregoing, we find that the mark shown in the drawing is a substantially exact representation of the mark shown on the specimens.

Decision: The requirement for a substitute specimen is reversed.